

Serial Number: 10/000,372Docket Number: 10005875-1**REMARKS**

Upon entry of this Response, claims 1-6 and 8-16 remain pending in the present patent application. Claims 8, 12-14, and 16 have been amended.

Applicants request reconsideration of the pending claims in view of the following remarks.

In item 2 of the Office Action claims 1-6 and 8-16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,149,323 issued to Shima (hereafter "Shima") in view of U.S. Patent 6,567,181 issued to Onozawa (hereafter "Onozawa"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). For the reasons that follow, Applicants assert that the rejection of claims 1-6 and 8-16 is improper. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn.

Claim 1 in its present state cites the following:

1. A method of controlling a printer using an application in a computer system, comprising:
 - downloading document content of the document to the computer system from a remote computer system;
 - setting an indicator if a set of content-provider-selected printer settings is unavailable to be downloaded to the computer system with the document;
 - choosing, in the computer system, a group of printer settings from a group of potential printer-setting sources;
 - associating, in the computer system, the printer settings with a document; and
 - sending the printer settings to the printer prior to printing the document;

wherein the potential sources include at least one set of user-selected printer settings selected by a user of the computer system, and a set of content-provider-selected printer settings selected by a content provider of the document if the set of content-provider-selected printer settings are available.

With respect to claim 1, the Office Action states in part:

"Shima differs from claims 1, 8, 10, 11, 12, 13, 14, 15, and 16 in that he does not clearly disclose downloading document content of the document to the computer system from a remote computer system and setting an indicator if a set of content provider selected printer settings is unavailable to be downloaded to the computer system with the document.

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Onozawa discloses downloading document content of the document to a computer system (1) from a remote computer system (20 and setting an indicator if a set of content provider selected printer settings is unavailable to be downloaded to the computer system with the document (column 5, lines 11-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Shima wherein document content is downloaded from a remote computer system. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Shima by teaching of Onozawa in order to reduce the storage capacity of the local computer system." (Office Action, page 3).

Applicants respectfully disagree. Specifically, Onozawa does not show or suggest downloading document content of a document to a computer system from a remote computer system and setting an indicator if a set of content provider selected printer settings is unavailable to be downloaded to the computer system with the document. Specifically, Onozawa discusses placing a printing request in a printing cue along with conditions that must be met in order to begin printing the document. The conditions are specific states of the documents to be printed as they are created.

For example, assuming that a number of individuals are working on portions of the same document, then the document may not be printed until each of the specific portions created by the various individuals have been approved or stored in a common location. (See Onozawa, column 6, line 41 – column 7, line 45.) With respect to the individual conditions, at column 5, lines 11-27 cited by the Office Action above, Onozawa states:

"When printing starting conditions have been designated (the answer for the question made in Step 103 is affirmative) in the printing request for the printing jobs made3, the request reception section 41 registers (Step 104) the job IDs for the mentioned printing jobs and the printing starting conditions in a mutually connected state in the printing condition control section 42, and further registers (Step 105) the printing jobs in the printing job control section 43 to complete (Step 107) the processing of the printing request received.

When printing starting conditions are not designed (the answer for the question made in Step 103 is negative) in the printing request for the printing jobs made in Step 102, the printing jobs are registered (Step 106) in a cue in the printing job control section 43 to complete (Step 107) the processing of the printing request received."

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As set forth above, if a printing request has conditions associated therewith then the request is placed in a special cue to wait for the conditions to be realized before printing begins. Otherwise, if no conditions are present, then the process of printing the print job begins immediately.

Claim 1 specifically cites "the downloading of document content to the computer system from a remote computer system and setting an indicator if a set of content provider selected printer settings are unavailable to be downloaded to the computer system with the document." The content provider selected printing settings are settings that may or may not be downloaded with the document, and the indicator is set if such settings are in fact downloaded with the document as set forth in claim 1.

No printing settings are downloaded with the documents as described by Onozawa. Rather, a document is forwarded to a print server with conditions for printing. Such conditions are not printer settings as claimed, and the printer settings are not downloaded from a common remote computer system with the document. Also, Onozawa does not even mention anything that can be interpreted as showing or suggesting the element of setting an indicator if the printer settings are unavailable to be downloaded with the document.

Accordingly, Applicants assert that the rejection of claim 1 is improper. In addition, Applicants assert that the rejection of claims 11, 13, and 15 is improper at least to the extent that such claims set forth the setting of an indicator if the set of content provider selected printer settings are unavailable to be downloaded to the computer system with the document as described above. Accordingly, Applicants request that the rejection of claims 1, 11, 13, and 15 be withdrawn. In addition, Applicants request that the rejection of claims 2-6 be withdrawn as depending from claim 1.

In addition, claim 8 has been amended herein to recite as follows:

8. A method of printing remote documents from a local computer system, comprising:
subscribing to a document provided by a remote computer system;
associating, with the document, in the local computer system, a set of document-specific printer settings, if available;
setting an indicator to indicate that the document-specific printer settings have been associated with the document;
downloading document content of the document from the remote computer system;

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choosing printer settings for printing the document from a group of potential printer-setting sources, wherein the group of potential sources includes the set of document-specific printer settings; and

sending the printer settings and the document content to a printer.

Applicants assert that the same combination of references fails to show or suggest each of the elements of claim 8 as amended above. Specifically, the stated combination of *Shima* and *Onozawa* fails to show at least the element of setting an indicator to indicate that the document specific printer settings have been associated with the document. Specifically, *Onozawa* discusses the concept of conditional printing as described above.

Accordingly, Applicants assert that the cited combination above fails to show or suggest each of the elements of claim 8. In addition, Applicants assert that the cited combination of references fails to show or suggest each of the elements of claims 12, 14, and 16 as amended. Accordingly, Applicants request that the rejection of claim 8, 12, 14, and 16 be withdrawn. In addition, Applicants request that the rejection of claims 9-10 be withdrawn as depending from claim 8.

Also, claims 13 and 14 have been amended herein so as to appear in proper means plus function format as provided by 35 U.S.C. §112, paragraph 6.

CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding this response, the Examiner is encouraged to telephone the undersigned counsel of Applicants.

Respectfully submitted,


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